

Attorney Docket No.: UT-0033
Inventors: Mujtaba et al.
Serial No.: 10/009,455
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REMARKS

Claim 5 is pending in the instant application. Claim 5 has been rejected. Claim 5 has been amended. Support for this amendment is provided in the specification at pages 11-12. Thus, no new matter is added by this amendment. Reconsideration is respectfully requested in light of the amendment and the following remarks.

Rejection under 35 U.S.C. 103(a)

Claim 5 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Rao et al. (March 1998, Reference BF) in view of Rao et al. (U.S. Patent 6,361,996). The Examiner suggests that Rao et al. (1998) teach isolated glial restricted precursor cells from spinal cords of rats using procedures of in vitro immunoreactivity. Further the Examiner suggests that Rao teaches that the best defined glial precursor cells are the A2B5+ progenitor cells (stem cells) isolated from rat embryos. The Examiner suggests that it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to isolate the glial restricted precursor cells as disclosed by Rao et al. from a mouse because U.S. Patent 6,361,996 also disclosed mouse to be a source of precursors as well, for carrying out the steps of incubating and isolating via

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immunoselection in a method for isolating glial restricted precursor cells.

Applicants respectfully traverse this rejection.

The mouse embryonic stem cells used as the starting material in the instant claimed process are different from the A2B5+ progenitor cells taught by Rao et al. which the Examiner has characterized as "stem cells". In particular, the A2B5+ progenitor cells are derived from fetal tissue. In contrast, at page 11-12 of the instant application, an advantage of using mouse ES cells is taught to be that it bypasses the need to harvest cells from fetal tissue. The term "embryonic stem cells" is well known in the art to refer to embryonic innercell mass derived (or blastocyst derived) embryonic stem cells. Further, the A2B5+ progenitor cells taught by Rao et al. are neural tissue specific progenitor cells. In contrast, the mouse embryonic stem cells used in the instant invention contribute to all cell lineages. See page 12 of the instant specification.

U.S. Patent 6,361,996 also provides no teaching or suggestion with respect to use of embryonic stem cells from a cell line which contributes to all cell lineages to isolate a pure population of mouse glial-restricted precursor cells.

Accordingly, in an earnest effort to advance the prosecution of this case and clearly distinguish the

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starting material used in the instant claimed invention from starting material used in the instant claimed invention from the A2B5+ progenitor cells taught by Rao et al. and teachings of U.S. Patent 6,361,996, Applicants have amended claim 5 to state that mouse embryonic stem cells from a cell line which contributes to all cell lineages are incubated under differentiation-inducing conditions so that the cells differentiate. Support for this amendment is provided in the instant specification at page 12.

MPEP 2116.01 is clear: All the limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness of a process or method claim. Proper claim construction requires treating language in a process claim which recites the making or using of a nonobvious product as a material limitation. Motivation to make or use the nonobvious product must be present in the prior art for a 35 U.S.C. 103 rejection to be sustained. MPEP 2116.01.

Since both Rao et al. and U.S. Patent 6,361,996 are silent with respect to use of mouse embryonic stem cells from a cell line which contributes to all cell lineages as a starting material in a process for isolating a pure population of mouse glial-restricted precursor cells, these references clearly provide no motivation to use embryonic stem cells as claimed.

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Accordingly, this rejection under 35 U.S.C. 103 should not be sustained.

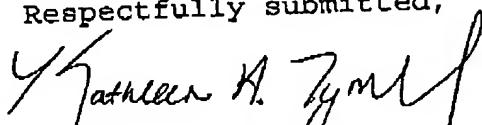
Withdrawal of this rejection under 35 U.S.C. 103(a) is therefore respectfully requested.

Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record.

Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,



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